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In Re Application of: Issam Abouloukme
US Application Number: 10/519,269
Filing Date: 22 December 2004
Title: Retractable Self Rolling Blind, Awning or Cover Apparatus
Group Art Unit: 3634
Examiner: Glessner, Brian E
Attorney Docket No: ABO0002U

11 February 2007

**Amendment after Advisory Action and
Before Appeal**

Dear Sirs,

Background

The Applicant is in receipt of the Advisory Action, received 16 November 2007, in respect of the above referenced application. In the Advisory Action, the Examiner maintained the rejections against claims 1, 3-5, and 7-9 of the present application. The rejections were made on the ground of non-statutory double patenting over claims 1, 2, 5, 6, 8, and 12-16 of US 6,948,542 (the '542). The Applicant hereby requests that a claim amendment bringing the claims into condition for allowance be entered.

Amendments and arguments are now provided that clearly distinguish the invention from the citations. Claims 4 and 5 have been cancelled. Amendments are proposed to avoid Appeal or to sharpen the issues for Appeal.

Amendments and Reasoning

None of the referenced claims recite a C-shaped track plus carriage with wheels in front and behind keyway tube. None of the present claims recite a tension bar. The C-shaped track plus carriage is not equivalent to a tension bar or rolling apparatus.

1. Amendment to Claim 1 will bring all Rejected Claims into Condition for Allowance

The examiner is urged to recognize that although he is entitled to interpret “rolling apparatus” in the referenced claims quite broadly, the referenced patent teaches only those kinds of rolling apparatus that can be used in conjunction with a tension bar. Because the tension bar is present, a wide variety of rolling apparatus can be used. The “rolling apparatus” in the referenced patent and referenced claims does nothing in regard of spring tension. In effect, the spring tension is independent of what kind of rolling apparatus is used. This is precisely because the tension bar performs the function of allowing the spring to be contensioned when the keyway tube is rotated. If the tension bar of the referenced claim is removed, the device will not work. It will not work because the fixed end of the spring is free to rotate and thus tension never develops in the spring. This problem is solved in the instant claims by immobilizing the carriage with respect to the keyway tube. The carriage is immobilized by providing wheels in front of and behind the keyway tube by locating those wheels in a C-shaped track. There is no reference of a C-shaped track in carriage apparatus in the referenced claims or in the referenced specification. The two work completely different to maintain spring tension. The resulting structures are entirely different.

During prosecution, the Examiner and the Applicant considered the patentability of the present claims. The Examiner rejected claim 3 on the basis that the “carriage” recited in the present claims was the equivalent of the “rolling apparatus” recited in the referenced claims. The Examiner specifically stated in the Advisory Action that the claims were

rejected because “the ‘rolling apparatus’ of claim 1 of ‘542 is the functional equivalent of recited ‘carriage’.” The examiner ignored the role of the tracks of claim 3. A fair consideration of the instant specification reveals the role of the tracks in combination with the carriages (wheels front and behind) in stabilizing the ends of the keyway tube allowing the spring to become tensioned, that is, in fulfilling the function of the tension bar 15 of the referenced claims.

To better distinguish the claimed inventions away from the referenced inventions, the Applicant hereby submits an amendment to claim 1, under 37 CFR 41.33. The requested amendment restricts the scope of claim 1, by adding the integer “the pre-determined path being a C-shaped channel.” This amendment is supported by the specification. Figures 1 to 4 of the present application shows that the carriages travelling in C-shaped channels (ref 22).

According to the teaching in the ‘542, the “tension bar” keeps the spring mechanism within the keyway tube in torsion while the keyway tube travels. No other structure in any of the referenced inventions has this function.

Unlike the referenced inventions, none of the presently claimed inventions comprises the tension bar. Yet, each invention defined by the present claims retains the function of keeping the spring mechanism in torsion. The function is provided by the combination of the C-shaped channel and the carriage. According to the present application, the C-shaped channel (ref 22) restricts any twisting movement of the carriage with respect to the keyway tube. The C-shape prevents the carriage from twisting inside the track or twisting out of the channel. Therefore, the combination of the carriage and the track prevents the spring tension mechanism within the keyway tube from unwinding (p.3, ll.16-20). The same function that is performed by the “tension bar” in each of the referenced invention is thus retained, even though the presently claimed inventions do not comprise a tension bar.

Therefore, the Applicant’s proposed amendment adds a structural limitation that is absent in the referenced claims, and clarifies the patentability of the rejected claims over the ‘542 claims. The amendment brings claims 1, 3-5, and 7-9 of the present application into condition for allowance. The Applicant requests that the amendment be entered.

2. Claim 7 requires that two or more self rolling cover apparatuses as defined by claim 1 are coupled together. The Examiner contended that it would have been obvious to “modify the self-rolling blind device disclosed by the ‘542 by coupling together multiple of the apparatuses together as taught by Brodie.”

In order for the Examiner’s combination to be possible, the referenced inventions would need to have structures such as shafts or tracks that run along the sides of the sheets. Without such structures, it would be impossible to combine two of any of the referenced inventions together using the combination technique taught in the ‘423.

None of the referenced inventions comprises any tracks or shafts suitable for the combination method taught by the ‘423. Therefore it is impossible to combine two of any of the referenced inventions together using the method taught by the ‘423. The Examiner’s rejection against claim 7 is not made out.

3. Claim 8 is Patentable over Claims 1, 2, 6, 8, and 12-16 of the ‘542 in View of US4,502,674 (White et al, or the ‘674)

Claim 8 requires that a “horizontal ceiling portion is formed from one sheet of material, whilst a second sheet forms a wall portion, the key way tube acting as a junction of the wall portion and ceiling portion.”

The Examiner stated that it would have been obvious for a person of ordinary skill to “modify the self-rolling blind device disclosed by the ‘542 with the vertical sheet as taught by White et al.”

The Examiner’s combination (of the ‘674 device with any of the inventions claimed by the ‘542) depends on the assumed obviousness, to one of ordinary skill, of isolating the vertical sheet from the ‘674 device and adding it to one of referenced inventions. This assumption is unfounded. The ‘674 device is an assembly of two equally necessary elements: a main panel and a drop panel (i.e. the vertical sheet) that is narrower than the main panel (see Figure 1 of the ‘674). The two elements work in a cohesive manner,

because one would not work without the other. The Examiner gave no evidence or reason for why a person of ordinary skill in the art would find it obvious to separate these two components and then add it to one of the referenced inventions.

The Examiner did not identify how anyone could combine one of the inventions defined by the '542 claims with a vertical sheet plucked from the '674 device. Without identifying the numerous modifications required, the Examiner had no way of determining whether the modifications would have been obvious.

The only discernible motivation, behind the Examiner's combination of the vertical sheet in the '674 and the inventions defined by the '542 claims, is to reconstruct the Applicant's invention in hindsight. The Examiner is not permitted to use hindsight reconstruction to defeat the patentability of the Applicant's invention. The rejection against claim 8 is not made out.

4. Claim 9 is Patentable over claims 1, 2, 5, 6, 8, and 12-16 of the '542.

In the Final Rejection, the Examiner stated that, with respect to claim 9 over the referenced claims, "there are no structural modifications necessary." The Examiner was wrong.

Claim 9 recites that the apparatus "functions as an extendible panel, the carriages being held in tracks." Two integers—the structural element of "tracks" and the retaining relationship between the "carriages" and the "tracks"—are clearly required by claim 9. These integers, however, are not recited by the referenced claims. Further, as stated in the '542 specification (c.6, ll.8-15), the referenced inventions are intended to run "on the ground" or "suspended". Therefore, the two aforementioned integers are not even intended by the referenced claims.

Conclusion

The Applicant requests that the claims be reconsidered." Claim amendment sheets are enclosed. This amendment would bring claim 1 and all its dependencies into allowance.

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Regards,



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Encl. Claim amendment sheet